

REMARKS / ARGUMENTS

The Applicants thank the Office for the careful consideration given to their application in the communication mailed 12/10/2009. In that communication, claim 2 was rejected under 35 U.S.C. 112, second paragraph, as having an improper Markush group. Claims 1 – 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over a York Flashing web reference in view of Ruiz et al. (US 2002/0152696 A1). Claims 21 – 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sourlis (US 6,023,892) in view of York Flashing and Ruiz et al.

The Applicants, however, object to their application being subjected to a *fourth* substantive examination and again being subjected to new grounds of rejection. Under 37 CFR 1.104(b) and MPEP 707.07, the rule is that “[t]he examiner's action will be complete as to all matters...” The present case has been subjected to substantive examinations on 10/19/2007, 08/07/2008, 02/05/2009, and 12/10/2009. The Applicants have responded to the satisfaction of the Office the first three times, as admitted in the Office’s Response to Arguments in its immediately following communications. This application should not be subjected to more 103(a) rejections. It appears that the examiner’s actions were not complete as to all matters. Furthermore, the Applicants have previously provided several declarations traversing rejection that show that the present invention is not obvious by providing secondary considerations of unobviousness. Also, three of the four independent claims (1, 21, and 24) have ***not*** been amended during prosecution, so nothing the Applicants have done has necessitated further searching or examination of those claims. Claim 17 was amended to narrow it, and not to shift claim scope. Therefore, the Applicants respectfully request reconsideration or withdrawal of the rejections communicated on 12/10/2009.

In the alternative, the Applicants respectfully submit this amendment and the following arguments. In this amendment, claim 2 is amended to separate the contents of the Markush group into different dependent claims. Copper remains in claim 2. New claims 25, 26, and 27 recite PVC, polyethylene, and stainless steel respectively. As a result, claim 2 complies with 35 U.S.C. 112, second paragraph, because there is no Markush claim.

The Applicants point out that the cited art does not have a polyethylene or stainless steel flashing. Because the cited art does not have all the elements of claims 26 and 27, they should be allowable.

With regard to all the rejections under 103(a), Applicants respectfully submit that the combination of York Flashing with Ruiz is improper because the Office Action relies on information gleaned solely from Applicants' specification. MPEP § 2142 states that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." "Any judgement [sic] on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper" (MPEP § 2145(X)(A), quoting *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

In the present case, regarding claim 1, the Office action relied on the reasoning that the claimed invention is "a combination of prior elements according to known methods to yield predictable results" to allegedly support the combination of the York Flashing with the wicking layer of Ruiz. However, the combination of prior elements according to known methods to yield predictable results is absent from the cited art and is only present in Applicants' specification in paragraphs 0017 and 0018 of the published application. In the cited section of the specification, it is discussed that a wicking cloth is provided and adhered to the second side of the flashing membrane. The materials and devices used previously do not have a wicking material as part of a flashing membrane. Due to

the lack of a wicking cloth adhered to a flashing membrane in the cited art and the fact that a wicking cloth adhered to a flashing membrane is only present on the record in Applicant's specification, it logically follows that the wicking cloth adhered to a flashing membrane has been improperly gleaned from Applicant's own specification and that the combination of the York Flashing reference with Ruiz is an exercise of impermissible hindsight. Accordingly, it is respectfully submitted that the combination is improper and respectfully requested that the rejection be withdrawn.

For the foregoing reasons, the Applicants suggest that all the pending claims are allowable, and respectfully requests that a Notice of Allowance be issued in this case.

Respectfully submitted,

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